

Notice of Allowability

Application No.

10/765,380

Examiner

Patricia C. Mallari

Applicant(s)

PERKINS ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the supplemental amendment filed 11/22/06.
2. ☒ The allowed claim(s) is/are 1-4, 19 and 20.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


CHARLES A. MARMOR II
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with James Heslin on 12/21/06.

The application has been amended as follows:

On line 10 of claim 1, "the closure element remains" was replaced with –upon deployment, the closure element is adapted to remain--.

On 10 of claim 20, "the closure element remains" was replaced with –upon deployment, the closure element is adapted to remain--.

On line 6 of p.1 of the specification, --, now US Patent No. 6,709,401— was inserted after 017534-000720US).

The changes to the claims were made to correct a problem under 35 U.S.C. 101 (non-statutory subject matter). The change to the specification was made to insert the US Patent Number.

The following is an examiner's statement of reasons for allowance:

US Patent No. 4,445,892 to Hussein teaches a system comprising a isolation/access catheter 120 having a proximal end, distal end, occlusion element 134 near the distal end, and at least one lumen 146 extending therethrough. A sealing

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catheter 124 has a proximal end, distal end, and receptacle 144 therein. A closure element 136 is releasably carried in the receptacle of the sealing catheter. The sealing catheter 124 may be introduced through the lumen of the isolation/access catheter 120 and the closure element may be deployed from the receptacle of the sealing catheter (see entire document, especially figs. 4 & 5 of Hussein). However, the system of Hussein does not include a closure element that is adapted to remain in the lung when the sealing catheter is removed. While it can be argued that the balloon or closure element 146 can be removed from the sealing catheter 124, such removal would result in a deflation of the balloon, such that the balloon would no longer be capable of "closure" and therefore not constitute a "closure element".

US Patent No. 6,174,323 to Biggs et al. teaches an isolation/access catheter 34 having proximal and distal ends and at least one lumen extending therethrough. A sealing catheter 35 has proximal and distal ends and a receptacle therein. A closure element 128 is releasably carried by the sealing catheter. The sealing catheter 35 may be introduced through the lumen of the isolation/access catheter and the closure element may be deployed from the sealing catheter such that, upon deployment, the closure element is adapted to remain in the lung when the sealing catheter is removed (see entire document, especially figs. 8-10 of Biggs). However, the isolation/access catheter lacks an occlusion element near the distal end and the closure element is not carried in the receptacle of the sealing catheter, as claimed. Furthermore, there appears to be no motivation to combine the system of Hussein with that of Biggs.

Therefore, the prior art of record fails to teach or fairly suggest a system for performing intraluminal lung volume reduction wherein the isolation/access catheter has an occlusion element near its distal end, the closure element is releasably carried in the receptacle of the sealing catheter, the sealing catheter may be introduced through the lumen of the isolation/access catheter, and the closure element may be deployed from the receptacle of the sealing catheter such that, upon deployment, the closure element is adapted to remain in the lung when the sealing catheter is removed, in combination with all of the other limitations of the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

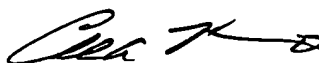
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia C. Mallari whose telephone number is (571) 272-4729. The examiner can normally be reached on Monday-Friday 10:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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